UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,060	12/16/2003	Thomas J. Dinger	LOT920030029US1 (014)	5227

46321   7590   07/06/2011
CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 2022
BOCA RATON, FL 33487

EXAMINER
HU, KANG

ART UNIT	PAPER NUMBER
3715	

MAIL DATE	DELIVERY MODE
07/06/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte THOMAS J. DINGER and FERNANDO SALAZAR

_____

Appeal 2010-003032
Application 10/737,060
Technology Center 3700

_____

Before SCOTT R. BOALICK, KEVIN F. TURNER, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 1-19, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part and enter new grounds of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

Appellants' invention relates to a method and system for administering learning objects within a learning management system. (Spec. Abstract.) A user can select various learning objects and can aggregate these learning objects in a learning folder directly on the system. (Spec. Abstract.) The user can also allow other learners in the system to access this learning folder. (Spec. Abstract.)

Claim 1 is exemplary (with disputed limitations in italics):

> 1.   A method of administering learning objects within a learning management system, comprising the steps of:
>
> establishing within a computing system a learning folder for a particular learner in the learning management system (LMS) which is separate from an existing selection of learning objects, the learning folder comprising a configuration to aggregate access to learning objects from the separate existing selection of learning objects;
>
> adding within the computing system one or more of the learning objects to the learning folder; and,
>
> *initially limiting access to the learning folder within the computing system to the particular learner.*

Claims 1-8 and 17-19 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1, 3, 4, 9, 11, 12 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rukavina (U.S. Patent Application Publication No. 2002/0188583).

Claims 2, 5-8, 10, 13-16, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being obvious over Rukavina and Alcorn (U.S. Patent No. 6,988,138).

With respect to claims 1-8 and 17-19, we are persuaded by Appellants' arguments (Br. 5-8) that these claims comply with 35 U.S.C. § 101 as statutory subject matter. Independent claim 1 recites "establishing within a computing system a learning folder," "adding within the computing system one or more of the learning objects to the learning folder" and "initially limiting access to the learning folder within the computing system." Independent claim 17 recites "[a] learning management system (LMS) . . . disposed within a computing system," "learning objects disposed within a computing system" and "a learning folder management user interface within the computing system."

With respect to independent claim 1, the Examiner found that "the claim does not make any implicit or explicit recitations of a particular machine which is critically tied to the performance of the method." (Ans. 3.) The Examiner also found that the claim language a "computing system" is a recitation of intended use. (Ans. 3-4.) We do not agree.

Claim 1 recites "establishing *within a computing system* a learning folder," "adding *within the computing system* one or more of the learning objects to the learning folder" and "initially limiting access to the learning folder *within the computing system*" (emphasis added). In other words, because claim 1 ties the method steps of "establishing," "adding" and "limiting" to the claimed "computing system," claim 1 is tied to a particular machine. *See Bilski v. Kappos,* 130 S.Ct. 3218, 3227 (2010) ("[T]he machine-or-transformation test is a useful and important clue, an

3

investigative tool, for determining whether some claimed inventions are processes under § 101.").

Therefore, we do not agree with the Examiner that method claim 1 not eligible as statutory subject matter.

With respect to independent claim 17, the Examiner found that the recitation of a learning management system in the preamble is "merely software programs for managing the course contents." (Ans. 4.) The Examiner also found that the claim language a "computing system" is a recitation of intended use and thus the "components [are] disposed within a computing system are no more than abstract data structures, and software per se." (Ans. 4.) We do not agree.

The body of claim 17 recites "learning objects *disposed within a computing system*" and "a learning folder management user interface *within the computing system*" (emphasis added). In other words, the "learning objects" and the "learning folder management user interface" are both elements relating to the "computing system." Therefore, "[a] learning management system (LMS) . . . disposed within a computing system" is directed towards the statutory class of a "machine" under 35 U.S.C. § 101.

Therefore, we do not agree with the Examiner that claim 17 is an abstract data structure.

Accordingly, we reverse the rejection of independent claims 1 and 17 under 35 U.S.C. § 101. Claims 2-8, 18 and 19 depend from claims 1 and 17 and we reverse the rejection of these claims under 35 U.S.C. § 101 for the reasons discussed with respect to claims 1 and 17.

With respect to independent claim 1, we are persuaded by Appellants' arguments (Br. 11-12) that Rukavina does not teach "initially limiting access to the learning folder within the computing system to the particular learner."

The Examiner found that the disclosure in Rukavina of a student receiving an individually created course corresponds to the claim limitation of "initially limiting access to the learning folder within the computing system to the particular learner." (Ans. 5-6.) In particular, the Examiner found that "a student may instantaneously receive a course that has been individually created for him or her, therefore the system initially only provide[s] the course content to the particular user that is individually created for – limiting access." (Ans. 5-6.) We do not agree.

Rukavina describes a "computer-based learning tools that provide course content via a network." (¶ [0002].) Rukavina teaches an e-learning tool 100 including a Learning Management System (LMS) 145 (¶ [0030]; fig. 1) that contains a student's individualized profile 150 and profile elements 155 (¶ [0040]). Rukavina also teaches that a student can request a course (¶ [0071]) and "instantaneously receive a course that has been individually created for him or her" (¶ [0072]). However, Rukavina is silent regarding another student's access to the requested course. Thus, the Examiner has not provided an adequate explanation as to how the instantaneous delivery of an individually created course corresponds to the claim limitation of "initially limiting access to the learning folder within the computing system to the particular learner."

Therefore, we cannot agree with the Examiner that Rukavina teaches "initially limiting access to the learning folder within the computing system to the particular learner."

Accordingly, we reverse the rejection of independent claim 1 under 35 U.S.C. § 102(b). Claims 3 and 4 depend from claim 1 and we reverse the rejection of these claims under 35 U.S.C. § 102(b) for the reasons discussed with respect to claim 1.

Independent claims 9 and 17 recite limitations similar to those discussed with respect to independent claim 1. We reverse the rejection of these claims, as well as claims 11 and 12, which depend from claim 9, for the reasons discussed with respect to claim 1.

NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b)

We enter the following new grounds of rejection:

Claims 1, 9 and 17 are rejected under 35 U.S.C. § 103(a) as being obvious over Rukavina and Alcorn.

The Rukavina teaches all the features of claim 1 except "initially limiting access to the learning folder within the computing system to the particular learner." Additionally, Rukavina teaches "profile elements 155 within a student's individualized profile 150" (¶ [0040]) such that one of the profile elements 155 includes a "Course selection" (fig. 1) corresponding to the claimed "learning folder."

Alcorn describes "systems and methods for the exchange of information between instructors and students in an educational context" (col. 1, ll. 17-19) over an electronic network such as the Internet (col. 1, ll. 25-26). In one embodiment, Alcorn teaches that an instructor can create an online course that may be taken by anyone else connected over the Internet. (Col. 6, ll. 10-13, 16-17.) The instructor can also configure the system to require the entry of a password to enroll in the online course and disseminate the password to desired students. (Col. 6, ll. 16-20.)

6

A person of ordinary skill in the art would have recognized that incorporating the known password entry of Alcorn with the profile elements 155 of Rukavina, including a "Course selection," would providing the advantage of controlling access to the student's profile elements 155. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Therefore, independent claim 1 is obvious under 35 U.S.C. § 103(a) over the combination of Rukavina and Alcorn.

Independent claims 9 and 17 recite limitations similar to those discussed with respect to independent claim 1. Therefore, claims 9 and 17 are obvious under 35 U.S.C. § 103(a) for the reasons discussed with respect to claim 1.

Because the Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination, we have not reviewed dependent claims 3, 4, 11 and 12 to the extent necessary to determine whether the combination of Rukavina and Alcorn renders any of these claims obvious. We leave it to the Examiner to determine the appropriateness of any further rejections of dependent claims 3, 4, 11 and 12 under 35 U.S.C. § 103(a).

Although Appellants nominally argue the rejection of dependent claims 2, 5-8, 10, 13-16, 18 and 19 separately (Br. 12), the arguments presented do not point out with particularity or explain why the limitations of the dependent claims are separately patentable. Instead, Appellants argue that the "Examiner naturally has failed to locate all claimed aspects of claims 2, 5 through 8, 10, 13 through 16 and 18 through 19 in the combination of Rukavina and Alcorn." (Br. 12.) We are not persuaded by these arguments for the reasons discussed with respect to the new grounds of

rejection of claims 1, 9 and 17, from which claims 2, 5-8, 10, 13-16, 18 and 19 depend. Accordingly, we sustain this rejection.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that a "new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ….

> (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ….

DECISION

The decision to reject claims 1-8 and 17-19 under 35 U.S.C. § 101 is reversed.

The decision to reject claims 1, 3, 4, 9, 11, 12 and 17 under 35 U.S.C. § 102(b) is reversed.

The decision to reject claims 2, 5-8, 10, 13-16, 18 and 19 under 35 U.S.C. § 103(a) is affirmed.

Claims 1, 9 and 17 are rejected as obvious over Rukavina and Alcorn.

New grounds of rejection have been entered under 37 C.F.R. § 41.50(b).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

cu